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*11/12 Reconsideration 8/22/03 [Signature]*  
**PATENT APPLICATION**

TECHNOLOGY CENTER IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Motohiko SAKAMAKI et al.

Group Art Unit: 2871

Application No.: 09/619,606

Examiner: T. Duong

Filed: July 19, 2000

Docket No.: 106794

For: METHOD FOR MANUFACTURING IMAGE DISPLAYING MEDIUM

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the June 4, 2003 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-19 are pending.

The Office Action rejects claims 1-4 and 15-19 under 35 U.S.C. §103(a) over U.S. Patent 2,940,847 to Kaprelian. The rejection is respectfully traversed.

Kaprelian does not describe "first, providing plural colorant particles on at least one of a first flat substrate and a side of a second substrate on which a spacer is provided to maintain a distance to the first substrate upon superimposing on the first substrate; and second, fixing the first substrate and the spacer on the second substrate to arrange the colorant particles between the first substrate and the second substrate," as recited in claims 1, 2, and 16, "first, providing plural colorant particles on one or both of a first flat substrate and a second flat substrate and providing a spacer member on one of the first substrate and the second substrate; and second, arranging the colorant particles and the spacer member between the

first substrate and the second substrate by fixing the spacer member, the first substrate and the second substrate," as recited in claim 3, 4, or 17, or "first, providing plural colorant particles on one or both of a first flat substrate and a second flat substrate, which have such shapes that the first substrate and the second substrate are mated with each other; and second, making the first substrate and the second flat substrate to fix the first substrate and the second substrate," as recited in claim 15 and 19.

In fact, Kaprelian does not disclose, teach, or suggest the use of a spacer at all. The Office Action alleges that it is obvious a spacer member is to be provided on one of the substrates to maintain a distance between the two substrates. Essentially, the Patent Office is arguing that a spacer member between the substrates is inherent in Kaprelian according to MPEP §2112. Admittedly, as evidenced by the claimed invention, providing a spacer member on one or both of the substrates is one method for spacing two substrates apart. However, it is not the only method. For example, in Fig. 16 of Kaprelian, substrates 102 and 106 are spaced apart by a series of rollers 104, 110 (col. 5, line 57-col. 6, line 8) rather than spacer members fixed between the substrates. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of the characteristic" (MPEP §2112). Because Kaprelian merely discloses that the substrates are "spaced apart" (col. 3, lines 37-39; col. 4 lines 63-67) and providing a spacer member on one or both of the substrates is not the only method for spacing two substrates apart, it is far from obvious (or inherent) that a spacer member is provided on one of the substrates to maintain that distance.

Furthermore, assuming the spacer is provided on one of the substrates in Kaprelian, that spacer is not fixed between the first substrate and the second substrate. In fact, the substrates in Kaprelian are not fixed to one another in any manner. This fact is clearly demonstrated by the ordered and enumerated steps that "must be performed in the

approximate order shown" in Kaprelian: "(4) migration of either the charged or the discharged particles of step 3, corresponding to the image, to a new surface or new location. (5) fixing or receiving onto a final support surface migrated or non-migrated particles, or both to form a final fixed color image" (col. 3, lines 14-29). It is clearly demonstrated in the figures and specification of Kaprelian, that the final fixed color image is fixed or received onto a final single support (col. 3, lines 27-29; col. 5, lines 23-30; Figs. 7-14). Therefore, the support of step 3 and the new surface or location of step 4 cannot be fixed together. They must be separated so the image may be transferred from the new surface or location of step 4 to the final support of step 5. This fact is further made clear when steps 4 and 5 are interpreted in conjunction with Figures 7-14.

In Figures 7 and 8, the particles begin on the substrate 40 (steps 1-3; col. 3, lines 33-54). Then, when a charge is applied, certain particles representing the image migrate to the substrate 44 (step 4; col. 3, lines 55-61). Finally, the substrate 40 of step 3 must be separated from the substrate 44 of step 4 so that the positive image may be transferred to the final support (not shown) of step 5 (col. 3, lines 61-71). The process is repeated in Figures 9 and 10 for subtractive images (col. 4, lines 4-50) and again in Figures 11-14 using a different type of particles (col. 4, line 54; col. 5, line 30).

Because the additive or subtractive image is transferred to a final support (not shown) in step 5, the two substrates 40 and 44 must be separable and therefore not each fixed to a spacer. Therefore, Kaprelian does not disclose, teach, or suggest all of the features of claims 1-4, 15-17, and 19.

Finally, were a spacer provided on one of the substrates in Kaprelian, it would cause a discontinuity in the electrophotographic image. The presence of such a discontinuity would suggest to one of ordinary skill in the art the undesirability of using a spacer in Kaprelian.

Therefore, in addition to failing to disclose, teach, or suggest the use of a spacer, Kaprelian actually teaches away from using a spacer.

Applicants respectfully point out that claim 18 depends from claim 5, which was not rejected. Thus, the rejection of claim 18 is in error (especially in light of the rejection of claim 5 and 18 in Item 4 of the Office Action).

Thus, for at least these reasons, Kaprelian does not render obvious the subject matter of claims 1-4 and 15-19 under 35 U.S.C. § 103(a). Accordingly, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 5 and 18 under 35 U.S.C. §103(a) as being unpatentable over Kaprelian in view of U.S. Patent 5,558,977 to DePalma et al. (hereinafter "DePalma"). The rejection is respectfully traversed.

The rejection is premised upon the assumption that Kaprelian generally teaches the fixing feature recited in claims 5 and 18. However, as discussed above with respect to claims 1, 3, and 15, Kaprelian does not disclose, teach, or suggest "first, providing plural colorant particles on one or both of a first flat substrate and a second flat substrate while masking one of the first substrate and the second substrate; second, after removing the mask, providing a spacer member on one of the first substrate and the second substrate; and third, fixing the spacer member, the first substrate and the second substrate so that the colorant particles and the spacer member are arranged between the first substrate and the second substrate," as recited in claims 5 and 18. Furthermore, DePalma does not make up for this deficiency of Kaprelian, as DePalma nowhere describes fixing a spacer member between two substrates. Thus, claims 5 and 18 are patentable over the asserted combination of Kaprelian and DePalma under 35 U.S.C. §103(a). As a result, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over Kaprelian in view of U.S. Patent 3,870,517 to Ota et al. (hereinafter "Ota").

The rejection is respectfully traversed.

As discussed above with respect to claims 1 and 3, Kaprelian does not disclose, teach, or suggest all of the features of claims 6 and 7. Ota does not make up for this deficiency of Kaprelian. As described in detail in Applicants' March 3, 2003 Amendment, Ota does not disclose, teach, or suggest that particles are provided on at least one of a first flat substrate and a second substrate before the first and second substrates are fixed. Thus, claims 6 and 7 are patentable over the asserted combination of Kaprelian and Ota under 35 U.S.C. §103(a). As a result, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over Kaprelian in view of DePalma as applied to claims 5 and 18, further in view of Ota. The rejection is respectfully traversed.

As discussed above with respect to claim 5, Kaprelian does not disclose, teach, or suggest all of the features of claim 8. Furthermore, as discussed above, DePalma does not make up for this deficiency of Kaprelian, as it nowhere describes fixing a spacer member between two substrates. Finally, as discussed above, Ota does not make up for the deficiency as it does not disclose, teach, or suggest that particles are provided on at least one of a first flat substrate and a second substrate before the first and second substrates are fixed. Therefore, the asserted combination of Kaprelian, DePalma, and Ota does not render obvious claim 8 under 35 U.S.C. §103(a). As a result, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 9, 10, 12, and 13 under 35 U.S.C. §103(a) as being unpatentable over Kaprelian in view of U.S. Patent 6,392,786 to Albert. The rejection is respectfully traversed.

As discussed above with respect to claims 1 and 3, Kaprelian does not disclose, teach, or suggest all of the features of claims 9, 10, 12, and 13. Albert does not make up for this deficiency of Kaprelian. Albert does not disclose, teach, or suggest "first, providing plural colorant particles on at least one of a first flat substrate and a side of a second substrate on which a spacer is provided to maintain a distance to the first substrate upon superimposing on the first substrate; and second, fixing the first substrate and the spacer on the second substrate to arrange the colorant particles between the first substrate and the second substrate," as recited in claims 9 and 12, "first, providing plural colorant particles on one or both of a first flat substrate and a second flat substrate and providing a spacer member on one of the first substrate and the second substrate; and second, arranging the colorant particles and the spacer member between the first substrate and the second substrate by fixing the spacer member, the first substrate and the second substrate," as recited in claims 10 and 13. In fact, the only particles disclosed in Albert are sealed in capsules containing a liquid (col. 2, lines 33-47; col. 15, line 51 - col. 17, line 62; Figs. 1-3). The capsules are then placed between two substrates with a spacer, rather than the particles (col. 2, line 33 - col. 4, line 19; col. 7, line 4 - col. 8, line 31; Figs 1-3). Thus, claims 9, 10, 12, and 13 are patentable over the asserted combination of Kaprelian and Albert under 35 U.S.C. §103(a). As a result, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 11 and 14 under 35 U.S.C. §103(a) as being unpatentable over Kaprelian in view of DePalma as applied to claims 5 and 18, further in view of Albert. The rejection is respectfully traversed.

The rejection is premised upon the assumption that the combination of Kaprelian and DePalma teaches each of the features of claim 5. As discussed above, Kaprelian and DePalma do not teaches each of the features of claim 5. As a result, it is respectfully requested that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:JOC/tea

Date: August 20, 2003

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